

EAST Search History

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S1	20	("5154172" "5179950" "5186170" "5188104" "5215086" "5231988" "5235980" "5269303" "5299569" "5335657" "5423877" "5707400" "5928272" "6473644" "6587719" "6609025" "6622038" "6622041" "6622047" "6721603").PN.	US-PGPUB; USPAT	OR	ON	2006/08/01 11:26
S2	28	((("3937226") or ("4088140") or ("4303075") or ("4332259") or ("4354497") or ("4458677") or ("4548203") or ("4928688") or ("4929688") or ("5174289") or ("5267560") or ("5501702") or ("5514161") or ("5584867") or ("5674259") or ("5720768") or ("5792203") or ("5797970") or ("5902324") or ("5977408") or ("5998386") or ("6141590") or ("6221851") or ("6381499") or ("6537540") or ("6572895") or ("6589954") or ("20010049543") or ("2002072782") or ("2003045909"))).PN.	US-PGPUB; USPAT	OR	OFF	2006/08/01 11:31
S3	79	osorio-\$.in.	US-PGPUB; USPAT	OR	ON	2006/08/01 11:32
S4	3731	gross-\$.in.	US-PGPUB; USPAT	OR	ON	2006/08/01 11:33
S5	2	((("20020072782") or ("20030045909"))).PN.	US-PGPUB; USPAT	OR	OFF	2006/08/01 11:34
S6	50	S1 or S2 or S5	US-PGPUB; USPAT	OR	ON	2006/08/01 11:36
S7	18	S6 and (neck or trachea or esophagus)	US-PGPUB; USPAT	OR	ON	2006/08/01 11:37
S8	18	S6 and (neck or trachea or (jugular adj vein) or esophagus)	US-PGPUB; USPAT	OR	ON	2006/08/01 11:37
S9	3	((("6308104") or ("5913876") or ("5651378"))).PN.	US-PGPUB; USPAT	OR	OFF	2006/08/01 20:39
S10	1	("5458625").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/01 20:40

Layno, Carl

From: Pezzuto, Robert
Sent: Friday, February 17, 2006 10:02 AM
To: Bockelman, Mark; Schaetzle, Ken; Layno, Carl; Mullen, Kristen; Oropeza, Fran; Malamud, Deborah L.; Reidel, Jessica L.; Johnson, Shevon E.; Heller, Tammie K.; Bertram, Eric D.; Gedeon, Brian T.; Patel, Joy; Lee, Yun Haeng; Patel, Natasha
Subject: FW: QPOD20 - Numerical ranges and Amounts Limitations

FYI.....

-----Original Message-----

From: Vidovich, Greg
Sent: Friday, February 17, 2006 9:25 AM
To: Shoap, Allan; Ashley, Boyer; Blau, Stephen; Casler, Brian; Bumgarner, Melba; Carter, Monica (AU3715); McDermott, Corrine; Banks, Derris; Look, Edward; Evans, Robin; Gartenberg, Ehud; Mancene, Gene; Bennett, Henry; Yuen, Henry; Huson, Gregory; Calvert, John; Hail, Joseph; Shaver, Kevin; Kim, Eugene; Dvorak, Linda; Mar, Michael; Hindenburg, Max; Yu, Mickey; Newhouse, Nathan; Nguyen, Anhtuan; Lucchesi, Nick; Vo, Peter; Pezzuto, Robert; Rada, Rinaldi; Robert, Eduardo; Scherbel, Dave; Sirmons, Kevin; Sykes, Angela; Thai, Xuan; Denion, Thomas; Thorpe, Timothy; Tyler, Cheryl; Yu, Justine; Zalukaeva, Tatyana; Jimenez, Marc; Cronin, Steve; Jones, Scott; Nguyen, George
Cc: Schmidt, Frederick; Recla, Henry; Hughes, Tom; Sholl, Linda; Harrison, Jessica; Mancene, Gene; Hastings, Karen
Subject: RE: QPOD20 - Numerical ranges and Amounts Limitations

If I missed a name above, particularly newly appointed Acting SPEs, please let me know....

QPOD20 - Numerical ranges and Amounts Limitations

MPEP 2173.05(c) Numerical Ranges and Amounts Limitations

Generally, the recitation of specific numerical ranges in a claim does not raise an issue of whether a claim is definite.

I. NARROW AND BROADER RANGES IN THE SAME CLAIM

Use of a narrow numerical range that falls within a broader range in the same claim may

render the claim indefinite when the boundaries of the claim are not discernible.

Description of examples and preferences is properly set forth in the specification rather

than in a single claim. **A narrower range or preferred embodiment may also be set forth in**

another independent claim or in a dependent claim. If stated in a single claim, examples

and preferences lead to confusion over the intended scope of the claim. In those instances where it is not clear whether the claimed narrower range is a limitation, a rejection under 35 U.S.C. 112, second paragraph should be made. The Examiner should analyze whether the metes and bounds of the claim are clearly set forth. Examples of claim language which have been held to be indefinite are (A) “a temperature of between 45 and 78 degrees Celsius, preferably between 50 and 60 degrees Celsius”; and (B) “a predetermined quantity, for example, the maximum capacity.” While a single claim that includes both a broad and a narrower range may be indefinite, it is not improper under 35 U.S.C. 112, second paragraph, to present a dependent claim that sets forth a narrower range for an element than the range set forth in the claim from which it depends. For example, if claim 1 reads “A circuit ... wherein the resistance is 70-150 ohms.” and claim 2 reads “The circuit of claim 1 wherein the resistance is 70-100 ohms.”, then claim 2 should not be rejected as indefinite.

II. OPEN-ENDED NUMERICAL RANGES

Open-ended numerical ranges should be carefully analyzed for definiteness. For example, when an independent claim recites a composition comprising “at least 20% sodium” and a dependent claim sets forth specific amounts of nonsodium ingredients which add up to 100%, apparently to the exclusion of sodium, an ambiguity is created with regard to the “at least” limitation (unless the percentages of the nonsodium ingredients are based on the weight of the nonsodium ingredients). On the other hand, the court held that a composition claimed to have a theoretical content greater than 100% (i.e., 20-80% of A, 20-80% of B and 1-25% of C) was not indefinite simply because the claims may be read in

theory to include compositions that are impossible in fact to formulate. It was observed that subject matter which cannot exist in fact can neither anticipate nor infringe a claim. In *re Kroekel*, 504 F.2d 1143, 183 USPQ 610 (CCPA 1974). In a claim directed to a chemical reaction process, a limitation required that the amount of one ingredient in the reaction mixture should “be maintained at less than 7 mole percent” based on the amount of another ingredient. The examiner argued that the claim was indefinite because the limitation sets only a maximum amount and is inclusive of substantially no ingredient resulting in termination of any reaction. The court did not agree because the claim was clearly directed to a reaction process which did not warrant distorting the overall meaning of the claim to preclude performing the claimed process. In *re Kirsch*, 498 F.2d 1389, 182 USPQ 286 (CCPA 1974). Some terms have been determined to have the following meanings in the factual situations of the reported cases: the term “up to” includes zero as a lower limit, In *re Mochel*, 470 F.2d 638, 176 USPQ 194 (CCPA 1974); and “a moisture content of not more than 70% by weight” reads on dry material, *Ex parte Khusid*, 174 USPQ 59 (Bd. App. 1971).

III. “EFFECTIVE AMOUNT”

The common phrase “an effective amount” may or may not be indefinite. The proper test

is whether or not one skilled in the art could determine specific values for the amount

based on the disclosure. See *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The phrase “an effective amount . . . for growth stimulation” was held to be definite where the amount was not critical and those skilled in the art would be able to

determine from the written disclosure, including the examples, what an effective amount

is. In *re Halleck*, 422 F.2d 911, 164 USPQ 647 (CCPA 1970). **The phrase “an effective amount” has been held to be indefinite when the claim fails to state the function**

which is to be achieved and more than one effect can be implied from the specification or the relevant art. *In re Frederickson* 213 F.2d 547, 102 USPQ 35 (CCPA 1954).

The more recent cases have tended to accept a limitation such as “an effective amount” as being definite when read in light of the supporting disclosure and in the absence of any prior art which would give rise to uncertainty about the scope of the claim. In *Ex parte Skuballa*, 12 USPQ2d 1570 (Bd. Pat. App. & Inter. 1989), the Board held that a pharmaceutical composition claim which recited an “effective amount of a compound of claim 1” without stating the function to be achieved was definite, particularly when read in light of the supporting disclosure which provided guidelines as to the intended utilities and how the uses could be effected.